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The opinion in support of the decision being entered
today, (1) was not written for publication in a law
journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 19

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

MAY 16 1997

Ex parte TOMOHORO KIKUDA

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 96-6777
App. est. of No. 08/205,063

HEARD: May 5, 1997

Before FRANKFORT, McQUADE, and NASE, Administrative Patent
Judges
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final
rejection of claims 1 through 7, which are all of the claims
pending in this application.

We REVERSE

Application for patent filed March 3, 1994

Appeal No. 96-0477
Application No. 08/205,061

BACKGROUND

The appellant's invention relates to a connection terminal assembly. Claim 1 is representative of the subject matter on appeal and a copy of claim 1, as it appears in the appellant's brief, is attached to this decision.

The prior art reference of record relied upon by the examiner as evidence of anticipation under 35 U.S.C. § 102(e) is:

Yagi et al. (Yagi)	5,240,434	August 31, 1993
		(filed Sep. 16, 1992)

Other prior art of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

the first conventional example shown in appellant's Figures 5 & 6
the third conventional example shown in appellant's Figures 11 & 12

Claims 1 through 7 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yagi.

Claims 1 through 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over appellant's admitted prior art Figure 5 taken with appellant's admitted prior art Figure 11.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the §§ 102(e) and 103

Appeal No. 96-0477
Application No. 08/205,061

Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

In this rejection, the examiner directed attention to Figures 5 and 6 of Yagi and stated that careful inspection of the prior art species shows an extremely similar connection terminal with the same shape retaining hole (answer, p. 4). Accordingly, we will direct our review of Yagi to the prior art species shown in Figures 5 through 7 and described in column 1, lines 8-64.

The prior art species disclosed by Yagi teaches the use of a connection terminal assembly comprising terminal b and a connector housing c formed with a flexible engagement piece d. The flexible engagement piece d has an engagement projection d₁ and a sloping notched guide projection d₂. The terminal b includes a cable connecting portion b₁, an electrical contact portion b₂ and an engagement hole b₃ formed in the base plate of the electrical contact portion b₂.

Independent claims 1 and 6 each recite that the terminal includes a retaining hole defined by a primary portion having a

Appeal No. 96-0477
Application No. 08/205,061

transverse width and a notched portion formed in a rear side of the primary portion.

The appellant argues that the prior art species disclosed by Yagi fails to anticipate the claims under appeal since the specific shape of the engagement hole b_3 is not disclosed. Thus, the shape of the retaining hole as recited in claim 1 and claim 6 is not met by the prior art species disclosed by Yagi. We agree. Our review of the prior art species disclosed by Yagi fails to reveal any disclosure that would enable an artisan to know the specific shape of the engagement hole b_3 . While the shape of the engagement hole b_3 could be rectangular or shaped to compliment the flexible engagement piece d having an engagement projection d_1 and a sloping notched guide projection d_2 , such conjecture is insufficient to support a rejection based on 35 U.S.C. § 102(e). This being the case, claims 1 and 6 are not anticipated by the prior art species disclosed by Yagi. Accordingly, we will not sustain the examiner's rejection of independent claims 1 and 6, and of dependent claims 2 through 5 and 7.

Next we turn to the examiner's rejection of claims 1 through 7 based on 35 U.S.C. § 103 as being unpatentable over appellant's admitted prior art Figure 5 taken with appellant's admitted prior art Figure 11. After considering the collective teachings of the

Appeal No. 96-0477
Application No. 08/205,061

admitted prior art, we must disagree with the examiner that the claimed invention would have been obvious to one of ordinary skill in the art at the time of the appellant's invention.

It is the examiner's position that one of ordinary skill in the art would have found it obvious to combine the connection terminal with the notched portion of Figure 5 with the connection terminal with the primary portion of Figure 11 (answer, p. 3). The examiner concluded that this combination would result in a retaining hole shaped as shown in appellant's sketch 1² (answer, p. 4). With this, however, we do not agree.

It is axiomatic that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting such combination. See In re Bond, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

We agree with the appellant that the admitted prior art fails to provide the needed suggestion or motivation to one of ordinary skill in the art at the time of appellant's invention to modify the

² See page 7 of the brief.

Appeal No. 96-0477
Application No. 08/205,061

admitted prior art as proposed by the examiner. That is, we agree that applying the combined teachings of the admitted prior art would not have resulted in a retaining hole defined by a primary portion having a transverse width and a notched portion formed in a rear side of the primary portion as recited in independent claims 1 and 6. It is our opinion that combining the teachings of the admitted prior art would have, at best, only resulted in a retaining hole as shown by appellant's sketch 2a.³ It appears to us that the examiner has used impermissible hindsight to reconstruct the claimed invention. Since the limitation that a retaining hole defined by a primary portion having a transverse width and a notched portion formed in a rear side of the primary portion is not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claims 1 and 6, and of dependent claims 2 through 5 and 7.

³ See page 8 of the brief.

Appeal No. 96-0477
Application No. 08/205,061

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 7 under 35 U.S.C. § 102(e) as being anticipated by Yagi is reversed; and the decision of the examiner to reject claims 1 through 7 under 35 U.S.C. § 103 as being unpatentable over appellant's admitted prior art Figure 5 taken with appellant's admitted prior art Figure 11 is reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge)

John P. McQuade
JOHN P. McQUADE
Administrative Patent Judge)

Jeffrey V. Nase
JEFFREY V. NASE
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Appeal No. 95-0477
Application No. 08/205,061

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Appeal No. 96-0477
Application No. 08/205,061

APPENDIX

1. In a connection terminal assembly having a retaining hole in which a retaining lance formed within a housing of a connector is engageable, the improvement wherein said retaining hole is defined by a primary portion, having a transverse width and a notched portion formed in a rear side of said primary portion; and a slanting surface portion corresponding to said notched portion is formed on a retaining projection formed on said retaining lance engageable in said retaining hole.